

REMARKS

The preceding claim amendments and the following remarks are submitted as a full and complete response to the Office Action issued August 11, 2008. Claims 36-53, 65-66, 70-87, 99-100, 104, and 106 have been amended. No new matter has been added. Accordingly, claims 36-107 are pending.

Claim Objections

Claims 37-52 and 104-107 have been objected to because of informalities. Claims 37-52, 71-86, 104, and 106 have been amended to correct the antecedent basis. Applicant respectfully requests that the claim objections be withdrawn.

Claim Rejections under 35 U.S.C. §112, first paragraph

The Office Action has rejected claims 36-107 as not enabled under 35 U.S.C. § 112, first paragraph. Applicant respectfully disagrees with the Office Action, and references the specification for enabling disclosure of the rejected claims. Nothing more than objective enablement is required, and therefore it is irrelevant whether this teaching is provided through broad terminology or illustrative examples. In re Wright, 999 F.2d 1557, 1562, (Fed. Cir. 1993).

Paragraph [0097] of the published application discloses a variety of advertisements that when “perceived” by a “recipient” tend to “interfere” with the primary message of the electronic greeting card. Specifically, “advertisements that are external to the subject matter viewed tend to clutter one’s computer display and/or to annoy or distract [i.e. ‘interfere’] the user from their intended focus.” Some of the “interfering” external advertisements include “advertisements in Web Pages or the like [that] include moving elements, such as, e.g., causing a banner ad to shake,

causing the coloring and/or images to change over time, etc., in fields outside of the user's intended field of focus [i.e., the field containing the primary message of the greeting card].” These types of “interfering” advertisements are a sharp contrast to the advertisements claimed in the present application. The claimed advertisements “can be substantially seamlessly incorporated into e-cards or the like in such a manner as to a) catch a users focus and attention without distraction by being integrated into the contend being viewed or the like, b) catch a users focus and attention by movement of the advertisement without distraction due to such integration.” This seamless integration can be enhanced when “the advertisement [] involve[s] an image of a product shown in the e-card and incorporated as subject matter within the content of the e-card (i.e., not independent from the subject matter of the e-card).” See Paragraph [0105]. While the “interfering” advertisements listed in the specification are not exclusive, the disclosure clearly enables the claimed invention. Applicant therefore respectfully requests that the rejection based on enablement be withdrawn.

Additionally, Applicant respectfully disagrees that the currently claimed invention fails to comply with the written description requirement. To satisfy the written description requirement of 35 U.S.C. § 112, first paragraph, an Applicant must convey with reasonable clarity to those skilled in the art that, as of the effective filing date, the Applicant was in possession of the invention. See Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1560 (Fed. Cir. 1991). It is clear from the specification, as described above, that the Applicant was in possession of the invention at the time of filing. Applicant therefore respectfully requests that the rejection based on written description be withdrawn. Further, Applicant respectfully requests that the claimed limitations be given full patentable weight.

Claim Rejections under 35 U.S.C. §112, second paragraph

Claims 36-107 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant has amended claims 48, 49, 65, 66, 82, 83, 99 and 100 to recite “said electronic greeting card is generated.” (emphasis added). Additionally, Applicant has amended claims 36, 53, 70 and 87 to indicate when an “electronic greeting card” is a “shell” or a “modified” “electronic greeting card.” Applicant now traverses the rejection.

Claim 70 (and similarly claims 36, 53, and 87) contains the limitation of “generating a shell electronic greeting card including a primary message.” The use of relative terminology in a claim, including terms of degree, does not automatically render a claim indefinite. See MPEP § 2173.05(b). When a term of degree is presented in a claim, the first inquiry is whether the specification provides some standard for measuring that degree. If it is concluded that the specification does not provide some standard for measuring the degree, a determination must then be made as to whether one of ordinary skill in the art, in view of the prior art and the status of the art, would nevertheless be reasonably apprised of the scope of the claimed invention. Id. In the current application, the specification provides “some standard for measuring the degree.”

At paragraph [0102], “[a]dvertisement [s]econdary to [p]urpose of [e]-card,” the specification describes the “purpose” of the e-card to which the advertisement is secondary, i.e., the primary message. This primary message or purpose of the card “may involve, e.g., the celebration or acknowledgement of a time based event,” and “the sender of the e-card may identify the purpose of the e-card by locating the e-card in a particular category of e-cards, such

as, e.g., in a listing of available birthday cards, anniversary cards, and/or the like.”

The limitation of a “message region” is adequately definite. For example, in FIG. 24(B) the portion of the e-card region stating “WHILE YOU’RE BUSY WATCHING YOUR SCREEN...” is contained in a message region. The interpretation of the Office Action is overly broad because it does not restrict the message region to the e-card, but rather to the “web page of a generated electronic greeting card.” The message region is not merely on the web page, but rather is part of the e-card.

The limitation of an “advertisement region” is adequately definite. For example, in FIG. 24(B) the portion of the e-card region referenced by the tag “INSIDE FIXED REGION AD,” refers to an example of a fixed “advertisement region.” The interpretation of the Office Action is overly broad because it does not restrict the advertisement region to the e-card, but rather to the “web page of a generated electronic greeting card.” The advertisement region is not merely on the web page, but rather is part of the e-card.

Claim 75 (and similarly claims 41, 58, and 92) contains the limitation “wherein said at least one advertisement region is fixed in relation to said at least one message region.” Claim 76 (and similarly claims 42, 59 and 93) contains the limitation “wherein said at least one advertisement region is mobile in relation to said at least one message region.” The Office Action’s interpretation that these limitations merely “refer to animations on an HTML page” is overly broad in light of the specification. Paragraphs [0072], [0073], and [0075] describe both the mobile and fixed advertisement regions. Specifically, paragraph [0072] states “the advertisement region moves with respect to time so as to effectively be part of an animation of the e-card.” This describes not merely an animation on an HTML page, but rather a specific

mobile advertisement region inside of an animated e-card. For example, Fig. 29 shows a Netflix advertisement inside of an animation; however, because the reference to Netflix is contained in the mobile advertisement region of the shell electronic greeting card it could easily be substituted out for a different company advertisement. See paragraph [0073]. Further, paragraph [0075] describes a fixed advertisement region, such as the region pointed to in FIG 24(B).

Claim 85 (and similarly claims 51, 68, and 102) contains the limitation of “said advertisement being part of said primary message.” The specification at paragraph [0079] describes that the advertisement “related to products having a logical relationship to the e-card.” Additionally, at paragraph [0105], the specification states, “[i]n some embodiments, the advertisement can involve an image of a product shown in the e-card and incorporated as subject matter within the content of the e-card (i.e., not independent from the subject matter of the e-card).” (emphasis added). Further, paragraph [106], in describing Fig. 30, states “[p]referably, however, the subject matter of the advertisement(s) should have some logical relation to the purpose of the card, such as, e.g., wherein a product image is used essentially as an active ... and/or passive prop.” Therefore, it is clear from the specification, that the limitation of “being part of said primary message” is not merely related to spatial orientation, but rather contextual perception and logical relation to the primary message or purpose of the e-card.

Claim 86 (and similarly claims 52, 69 and 103) contains the limitation “said advertisement being secondary to said primary message.” This limitation describes advertisements which are not “part of said primary message,” as described above. Therefore, the interpretation of the Office Action that the limitation “is met where prior art discloses sending e-cards(s) with personalized greetings along with an advertisement,” is overly broad. Rather, the

limitation is met where prior art discloses sending e-cards(s) with a primary message along with an advertisement that bears no logical or contextual relationship to the e-card.

The remaining rejected claims have previously been withdrawn in response to a restriction requirement. If the Examiner allows these claims to be rejoined, the Applicant will make the appropriate amendments at that time. Applicant therefore respectfully requests that the rejection based on 35 U.S.C. § 112, second paragraph be withdrawn, and the limitations be given full patentable weight.

Claim Rejections under 35 U.S.C. §102

Claims 36-40, 43-57, 60-74, 77-91 and 94-107, as interpreted, are rejected under 35 U.S.C. § 102(e) as being anticipated by Hasegawa, U.S. Patent No. 7,203,726. Applicant now traverses this rejection.

Hasegawa discloses a system and method for appending advertisement to music card, and storage medium storing program for realizing such method. Hasegawa discloses the use of banner advertisements which, according to FIG. 24(B) of the current specification, fall outside of the e-card. See Hasegawa Col. 6, Lns. 23-32. Additionally, this is precisely the type of advertising that the current invention discourages. See paragraph [0097].

Specifically, Hasegawa fails to disclose:

modifying said shell electronic greeting card to generate a modified electronic greeting card which include an advertisement integrated into said shell electronic greeting card, said advertisement including information regarding at least one consumer product, said advertisement being integrated into the shell electronic greeting card such that when seen the advertisement may be perceived by said at least one recipient as part of said modified electronic greeting card without interfering with said primary message of said modified electronic greeting card.

as recited in claims 36 and 70 (and similarly in claims 53 and 87) . (emphasis added). Hasegawa fails to teach or suggest that that an advertisement be integrated into the actual e-card. Though Hasegawa discloses choosing the advertisement based on keywords, this disclosure does not describe “said advertisement being integrated into the shell electronic greeting card such that when seen the advertisement may be perceived by said at least one recipient as part of said modified electronic greeting card without interfering with said primary message of said modified electronic greeting card,” as described above with reference to the claim rejections under 35 U.S.C. §112, first paragraph. Because Hasegawa fails to teach or suggest at least this limitation of claims 36, 53, 70, and 87 are allowable. Likewise claims 37-52 and 104 which depend from claim 36; claims 54-69 and 105 which depend from claim 53; claims 71-86, and 106 which depend from claim 70; and claims 88-103, and 107 which depend from claim 87 are all allowable.

The Office Action fails to set forth the grounds for the rejection of claims 53-57, 70-74, and 87-91. For at least this reason the rejection of these claims is improper and should be withdrawn. Further, Applicant will not speculate on the reasons for the rejection, but assert that these claims are not anticipated by Hasegawa, as discussed above.

Additionally, given the clarification of the limitations rejected under 35 U.S.C. § 112, Hasegawa fails to disclose the limitations of claims 43-44, 60-61, 77-78, and 94-95. Hasegawa fails to disclose “at least one advertisement region containing at least one image related to the consumer product,” as recited in claims 43, 60, 77, and 94. Hasegawa discloses the use of banner advertisements, which fall outside of the e-card. Therefore, Hasegawa fails to disclose “at least one advertisement region” inside of the e-card. For this reason, Hasegawa also fails to

disclose the limitation of claims 44, 61, 78 and 95. For this additional reason, claims 43-44, 60-61, 77-78, and 94-95 are allowable. Applicant respectfully requests that the rejection be withdrawn, and that the claims be allowed.

Claim Rejections under 35 U.S.C. §103

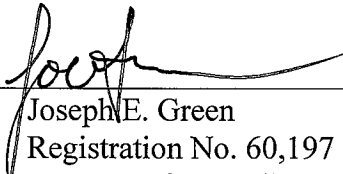
Claims 41-42, 58-59, 75-76 and 92-93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hasegawa in view of Chen, U.S. Patent No. 6,836,792. Applicant now traverses this rejection.

Chen discloses that advertisements may take the form of animations. However, Chen fails to disclose that an e-card contains at least one advertisement region that is either fixed or mobile in relation to a message region, as recited in claims 41-42, 58-59, 75-76 and 92-93. In fact, Chen fails to disclose either message or advertisement regions generally. Further, as discussed above Hasegawa fails to disclose advertisement regions. For at least this reason, claims 41-42, 58-59, 75-76 and 92-93 are allowable over the combination of Chen and Hasegawa.

In light of the foregoing, Applicant submit that all outstanding rejections have been overcome, and the instant application is in condition for allowance. Thus, Applicant respectfully request early allowance of the instant application. The Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-2135.

Respectfully submitted,

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